

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Plourde, et al.

Confirmation No.: 4414

Group Art Unit: 2616

Serial No.: 10/073,689

Examiner: Vent, Jamie J.

Filed: February 11, 2002

Docket No. A-7420 (191920-1190)

For: **MANAGEMENT OF TELEVISION PRESENTATION RECORDINGS**

REMARKS IN SUPPORT
OF PRE-APPEAL BRIEF CONFERENCE

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit the following remarks in support of a Request for Pre-Appeal Brief Conference.

It is believed a two-month extension of time is required. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

Applicants submit the following remarks in view of the Final Office Action mailed April 6, 2006 and the Advisory Action mailed June 30, 2006. Claims 3-5, 7-12, 14-15, 17-19, 21, 23-27, 29-32, 35-38 and 40-56 remain pending.

Claims 3-5, 7-12, 14-15, 17-19, 21, 23-27, 29-32, 35-38, and 40 - 58 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,832,385 to Young *et al.*, (“Young”), in view of U.S. Patent No. 6,481,011 to Lemmons (“Lemmons”). Applicants respectfully traverse these rejections for at least the reason that the proposed combination of *Young* and *Lemmons* does not disclose, teach, or suggest each and every limitation of Applicants’ claims as is required by 35 U.S.C. § 103. Accordingly, Applicants respectfully traverse this rejection of claims 3-5, 7-12, 14-15, 17-19, 21, 23-27, 29-32, 35-38, and 40-58, and respectfully submit that there exists clear error, supported by the evidence in the record, in this rejection.

Independent Claim 41

For example, the proposed combination of *Young* and *Lemmons* does not disclose, teach or suggest the feature of “***assigning a second color responsive to determining that the television presentation has a time scheduling conflict with the another television presentation that is scheduled to be recorded,***” nor the feature of “***presenting the television presentation listing as part of an interactive program guide (IPG) having the second color as a background color for the television presentation listing***” as recited in claim 41.

The Final Office Action indicates that *Young* “fails to disclose that the color of the conflict is a changeable color option.” *Final Office Action, page 2*. Applicants agree but respectfully submit that, even more than not disclosing a changeable color option, *Young* does not even disclose “a time scheduling conflict with the another television presentation that is scheduled to be recorded” as claimed. Even assuming, *arguendo*, that *Young* discloses: highlighting a program that is selected for recording; highlighting a program after that program has been recorded; and highlighting a mis-recorded cell with a different color/pattern than that of a recorded program or a program selected for recording, there is no disclosure of an event happening upon “a time scheduling conflict.”

The Advisory Action appears to assume that the “mis-recording” of *Young* is the same as the claimed “time scheduling conflict.” Even if, *arguendo*, the indication of a “mis-recorded cell” results from a time scheduling conflict (an event that *Young* does not disclose),

such an indication would be apparent only after the recording has taken place. Accordingly, for at least these reasons, *Young* does not disclose, teach, or suggest “assigning a second color responsive to determining that the television presentation has a time scheduling conflict with the another television presentation that is scheduled to be recorded” as recited in claim 41.

Applicants also traverse any finding that “it is well known in the art that if a conflict is occurring for more than one recording of a program the EPG will display the conflict to the user” as alleged on page 2 of the Advisory Action. Specifically, the only documentary evidence alleged to support this conclusory finding is that of *Young* which, as discussed, does not disclose this feature at all.

Neither does *Lemmons* address this deficiency. Applicants respectfully assert that *Lemmons* does not discuss time scheduling conflicts for scheduled programs at all, and consequently there is no disclosure of “assigning a second color responsive to determining that the television presentation has a time scheduling conflict with the another television presentation that is scheduled to be recorded,” as recited in claim 41.

Accordingly, Applicants respectfully submit that the combination of *Young* and *Lemmons* does not disclose, teach or suggest “assigning a second color responsive to determining that the television presentation has a time scheduling conflict with the another television presentation that is scheduled to be recorded.” Furthermore, because no color has been assigned responsive to determining that the television presentation has a time scheduling conflict with the another television presentation that is scheduled to be recorded, the proposed combination of *Young* and *Lemmons* does not disclose, teach or suggest “presenting the television presentation listing as part of an interactive program guide (IPG) having the second color as a background color for the television presentation listing.” Thus, a *prima facie* case of obviousness is not established based on *Young* and *Lemmons*. Consequently, for at least these reasons, among others, Applicants respectfully request that claim 41 be allowed and the rejection be withdrawn.

Because independent claim 41 is allowable over the proposed combination, dependent claims 3-5, 7-12, 14-15, 17-19, 21 and 42-45 are allowable as a matter of law for at least the reason that dependent claims 3-5, 7-12, 14-15, 17-19, 21 and 42-45 contain all elements of independent claim 41. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to dependent claims 3-5, 7-12, 14-15, 17-19, 21 and 42-45 should be withdrawn for at least this reason, among others.

Independent Claims 23 and 50

Claims 23 and 50, although different in scope from claim 41, include limitations similar to claim 41. Therefore, the discussion of claim 41 provided above also, in general, applies to these claims. Accordingly, the comments provided in relation to claim 41 will not be repeated herein for claims 23 and 50. However, Applicants submit that if more detail is needed, the arguments set forth in the Response to the Final Office Action mailed June 6, 2006 may be referenced for this purpose.

Dependent Claims 24-27, 29-32, 35-38, 40, and 51-56

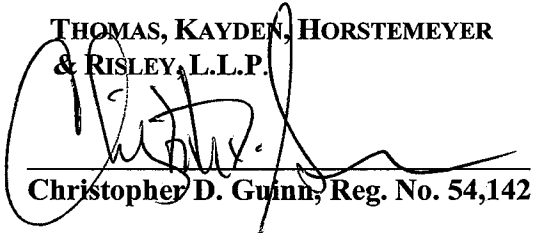
Because independent claim 23 is allowable over the proposed combination, dependent claims 24-27, 29-32, 35-38 and 40 are allowable as a matter of law for at least the reason that dependent claims 24-27, 29-32, 35-38 and 40 contain all elements of independent claim 23. Further, because independent claim 50 is allowable over the proposed combination, dependent claims 51-56 are allowable as a matter of law for at least the reason that dependent claims 51-56 contain all elements of independent claim 50. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to dependent claims 50-56 should be withdrawn for at least this reason, among others.

CONCLUSION

As is apparent from the foregoing, the cited art is woefully deficient in rendering Applicants' claims unpatentable. Therefore, application of *Young* in view of *Lemmons*, against Applicants' claims under 35 U.S.C. §103 rises to the level of clear legal and/or factual error. Applicants therefore request that the rejections of the Final Office Action and Advisory Action be withdrawn and a new, non-final Office Action, or Notice of Allowance, be issued.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**



Christopher D. Guinn, Reg. No. 54,142

100 Galleria Parkway, NW
Atlanta, GA 30339
Phone: (770) 933 - 9500
Fax: (770) 951 - 0933

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

A-7420 (191920-1190)

Application Number

10/073,689

Filed

February 11, 2002

First Named Inventor

Plourde, et al.

Art Unit

2616

Examiner

Jamie J. Vent

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

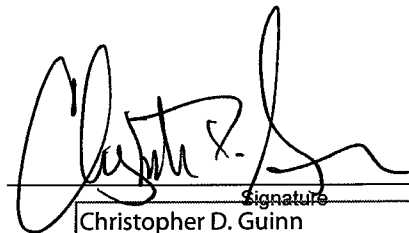
Registration number



attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

54,142


Signature
Christopher D. Guinn

Typed or printed name

(770) 933-9500

Telephone number

August 28, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.